REMARKS/ARGUMENTS

It is respectfully requested that the Examiner reconsider the rejections of the claims in light of the following amendments and remarks.

Claims 1 and 4-11 are pending in the present application. Claims 2 and 3 were previously cancelled. Claims 5-8, 10 and 11 are cancelled by the present Amendment. Reconsideration of the rejection of claims 1, 4 and 9 is respectfully requested.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 7 is cancelled in the present Amendment. The rejection is therefore rendered moot.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu et al., Genome Research, 1997, vol. 7, p. 389-398. Claims 6-8 are cancelled by the present Amendment. The rejection is therefore rendered moot.

Claims 5, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Skouv et al., U.S. Patent 6,303,315. Claims 5, 10 and 11 are cancelled by the present Amendment. The rejection is therefore rendered moot.

Claims 1, 4-5 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sorensen, et al., J. Virology, Dec. 1993, p. 7118-7124. Applicants respectfully traverse. Claim 1 is directed to a method for amplifying a target DNA fragment comprising providing a PCR primer that comprises a compound at the 5' terminus, wherein the compound may be a phosphate group. Claim 4 is dependent from claim 1, and further limits the PCR primer to either an asymmetric PCR or a degenerate PCR. Claim 5 is cancelled by the present Amendment. The Examiner states that "an oligonucleotide will have a phosphate group at the 5' terminus, by definition of its structure." (page 43 of the Office Action). Contrary to this statement, Sorensen does not teach a PCR primer or an oligonucleotide that comprises a phosphate group at the 5'

terminus. Chemically synthesized primers have hydroxyl groups at both ends (5' and 3'). In order to have a phosphate group at either end, a phosphorylation reaction must be conducted. Sorensen does not disclose such a phosphorylation reaction. Further, Sorensen does not provide any teaching or suggestion that a phosphate at the 5' end of a primer will improve the PCR amplification efficiency as would result from the method recited in claims 1 and 4 of the present patent application. Accordingly, claims 1 and 4 are not anticipated by Sorensen.

Claim 9 is directed to a method for amplifying a target DNA fragment comprising providing a PCR primer that comprises biotin at the 5' terminus; amplifying said target DNA fragment via PCR using the PCR primer; wherein the PCR is either one of asymmetric PCR and degenerate PCR. Sorensen discloses a combination of a non-biotinylated degenerate primer and a biotinylated non-degenerate primer. In contrast, claim 9 recites that the biotinylated PCR primer is degenerate. Further, Sorensen does not disclose or suggest the use of an asymmetric PCR primer. Accordingly, claim 9 is not anticipated by Sorensen. Claim 10 has been cancelled by the present Amendment.

It is respectfully requested that the Examiner withdraw the rejection of claims 1, 4 and 9 under 35 U.S.C. 102(b) as being anticipated by Sorensen.

Accordingly, it is respectfully submitted that the pending claims 1, 4 and 9 are now in a condition for allowance, early notice of which is earnestly requested.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By _____

Kent H. Cheng
Reg. No. 33,849
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: February 27, 2006